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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pfizer, Inc.

Serial No. 76253388

Nels T. Lippert of Hale and Dorr LLP for Pfizer, Inc.

Amos Matthews, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Cissel, Bottorff and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 7, 2001, Pfizer, Inc. applied to register the
mark THE PRIME OF OUR LIVES (typed) on the Principal
Register for "providing educational services, namely,
educational programs in the fields of health, health
awareness and health issues related to women over the age
of forty-five" in International Class 41.¹

¹ Serial No. 76253388. The application contains an allegation of
a bona fide intention to use the mark in commerce.

The examining attorney² refused to register applicant's mark on the ground that if the mark were used on or in connection with the identified services, it would so resemble the registered mark, FOR THE PRIME OF YOUR LIFE (typed), as to be likely to cause confusion, to cause mistake or to deceive.³ 15 U.S.C. § 1052(d). The services in the cited registration are identified as "association services, namely, promoting the interests of people in the prime of their lives by providing life skills information in the field of health, finances, career, relationships, recreational activities, spirituality, and the expansion of education backgrounds" in International Class 42.

After the examining attorney made the refusal final, applicant appealed to this Board.

The examining attorney maintains that the marks are substantially similar in sound, appearance, meaning, and commercial impression because the dominant portion of both marks is "prime" and "lives." He argues that the differences between the use of the singular and plural and the different possessive adjectives "our" and "your" are not significant. Regarding the services, the examining

² The current examining attorney was not the original examining attorney in this case.

³ Registration No. 2,340,672 issued April 11, 2000.

attorney introduced evidence to show registration of a common mark by a single entity for services similar to applicant's and registrant's. The examining attorney also noted that applicant's evidence of the weakness of the mark consisted of the submission of three registrations for services far removed from the health field.

Applicant asserts that the marks are not nearly identical and that the examining attorney discounts the significance of the "FOR THE" and "YOUR" in the registered mark and "THE" and "OUR" in its mark. The marks are also alleged to have different commercial impressions because applicant's mark "calls consumers to identify with each other in celebration of a special time in their collective lives" while the registered mark "connotes a particular service offered to benefit the particular consumer's personal life." Reply Brief at 1-2. Applicant argues that there is little chance of overlap of the services because applicant does not intend to use its mark with an association or with membership services and it is not offering life skills information. In addition, applicant asserts that since applicant's channels of trade are limited to women over forty-five, confusion is unlikely. Applicant also argues that the consumers are sophisticated

and that the registered mark is entitled to only a narrow scope of protection.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by comparing applicant's and registrant's marks.

Applicant's mark: THE PRIME OF OUR LIVES

Registrant's mark: FOR THE PRIME OF YOUR LIFE

Undeniably, there are differences between the marks. Registrant's mark adds the preposition "for;" the marks use slightly different possessive adjectives ("our" and "your"); and one uses the singular and the other uses the

plural for "life." Overall, these differences are slight and they may not even be noticed by many consumers.

Consumers are unlikely to rely on the introductory preposition "for" to distinguish the marks. In addition, while the possessive adjectives "our" and "your" have slightly different meanings in English (first person plural possessive and second person possessive, singular or plural), we do note that they are similar in appearance and pronunciation and even in meaning (possessive adjectives). As used in the middle of these phrases, it is hardly likely that consumers would rely on these factors to distinguish between the marks. The only other difference is the fact that one mark uses the singular "life" while the other uses the plural "lives." This is not significant. Wilson v. Delaunay, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word 'Zombie' and they will therefore be regarded here as the same mark").

If one were to study the marks THE PRIME OF OUR LIVES and FOR THE PRIME OF YOUR LIFE, slight differences in appearance and pronunciation would be apparent, but consumers would be unlikely to rely on these differences to distinguish the marks unless the marks have different

meanings and commercial impressions. Applicant argues that its mark calls consumers to identify with each other in celebration, while registrant's mark connotes a particular service offered to benefit the particular consumer's personal life. While applicant's argument regarding the meanings and commercial impressions of the marks is not beyond the realm of possibility, it is far more likely that consumers will understand the marks to suggest virtually the same thing, i.e. that the services provide information on how to enhance or extend the prime of the consumer's life.

We are mindful that the test for whether marks are so similar as to be likely to cause confusion is not a simple comparison of the individual elements of the mark, but rather whether, when we consider the marks in their entirety, they are similar. Considered in this way, we find that the marks are very similar. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("CASH MANAGEMENT ACCOUNT and THE CASH MANAGEMENT EXCHANGE are, in large part, identical in sound and appearance and have a general similarity in cadence"). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The,"

"Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion).

Applicant relies heavily on the case of Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). In that case, the Federal Circuit affirmed the Board's determination that the marks FROOTEE ICE and elephant design and FROOT LOOPS were dissimilar in appearance, sound, connotation, and commercial impression. Both the Board and the Court noted that the only similarity between the marks was that one mark began with the word FROOT and the other began with the word FROOTEE. 21 USPQ2d at 1144. Obviously, the present case is different in that both marks contain the same words or slight variations of these words, THE PRIME OF [Y]OUR LIFE[LIVES].

While we have compared the marks in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data, 224 USPQ at 751. While the marks are not identical, a "[s]ide-by-side comparison is not the test. The focus must be on the 'general recollection' reasonably produced by appellant's mark and a comparison of appellee's mark therewith." Johann Maria

Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972) (citation omitted).

We find that the marks are dominated by the phonetically very similar terms THE PRIME OF and LIFE/LIVES and that they are very similar in their appearance, pronunciation, meaning, and commercial impression.

Next, we consider whether the services of applicant and registrant are related. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources."

McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). We must consider the services as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); Dixie

Restaurants, 41 USPQ2d at 1534 (punctuation in original),
quoting, Canadian Imperial Bank of Commerce v. Wells Fargo
Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987)
("Likelihood of confusion must be determined based on an
analysis of the mark applied to the ... services recited in
applicant's application vis-à-vis the ... services recited in
[a] ... registration, rather than what the evidence shows the
... services to be").

The applicant's services are "providing educational
services, namely, educational programs in the fields of
health, health awareness and health issues related to women
over the age of forty-five." Registrant's services are
"association services, namely, promoting the interests of
people in the prime of their lives by providing life skills
information in the field of health, finances, career,
relationships, recreational activities, spirituality, and
the expansion of education backgrounds." Registrant's
association services involve providing life skills
information in the field of health. Applicant's services
involve providing educational services in the field of
health. In effect, both services involve providing
information in the field of health. Even if this aspect of
the applicant's and registrant's services is not identical,
that is not required. The question is whether potential

customers of registrant's association services of providing life skills information in the field of health would assume that there was some relationship between those services and applicant's educational programs in the field of health when the services are identified by similar marks. We hold that the services are related. Inasmuch as both applicant and registrant could be providing health information on the identical subject through their educational and association services, it is likely that these consumers will assume that the source of these services is the same, or at least related in some way.

The examining attorney has provided evidence in the form of use-based registrations that suggest that applicant's and registrant's services may originate from the same source. See Registration Nos. 2,671,825 (educational services, namely conducting educational programs on aspects of internal medicine and association services promoting the interest of doctors of internal medicine); 2,679,790 (educational services including conferences and distributing materials in the field of breast cancer diagnosis and treatment and association services promoting breast cancer awareness); 2,684,936 (educational services involving seminars relating to medicine and association services of promoting the

interests of medical professionals); 2,482,550 (educational services involving conducting courses on cancer and association services involving promoting the interest of pancreatic cancer research); and 2,669,161 (association services involving promoting the interests of end-of-life healthcare providers and educational services involving conducting conferences and workshops in the field of end-of-life care).

The examining attorney also included other registrations to show that a third party has registered its mark for educational services and for providing information in the field of health care. Registration Nos. 2,576,059; 2,562,400; 2,463,658; 2,567,682; 2,564,339; and 2,559,103. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). These registrations provide some support for the examining attorney's conclusion that the services of applicant and registrant are related.

Applicant also argues that "confusion is unlikely because Applicant's channels of trade are restricted to women over forty-five-years-old, which is not the normal channel in which Registrant's services are found." Brief at 9. While registrant's services promote the interest of "people in the prime of their lives," the examining attorney has included a definition (Office Action dated February 13, 2003) of "prime of life" as "the time of maturity when power and vigor are greatest." We agree with the examining attorney that this "meaning would very well include women over forty-five." Brief at 9. Thus, there would be at least some overlap between the potential customers for applicant's and registrant's services.

Applicant also argues that the purchasers of its services are "sophisticated and likely to make purchasing decisions." Brief at 10. While purchasers of health care services may be more careful, it is not clear from the record whether consumers interested in association services and educational services in the field of health care would make careful choices or be sophisticated purchasers. Indeed, by their own descriptions, applicant's and registrant's services imply that they will help educate potential purchasers of health care services to be more informed purchasers. There does not seem to be any reason

why ordinary consumers would not be included with the normal consumers of both applicant's and registrant's services.⁴

Applicant also argues that the registered mark is weak and entitled to only a narrow scope of protection. However, applicant's only evidence of the weakness of the registered mark consists of copies of three registrations for mail order services, banking services, and credit card services (Registration Nos. 1,536,927; 2,341,565; and 2,019,766).⁵ Obviously, these registrations are not

⁴ Even if we were to find that the customers of applicant's and registrant's services are careful and even sophisticated purchasers, this would not mean there would be no likelihood of confusion when marks as similar and services as related as those in this case are involved. In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products").

⁵ Applicant's brief and request for reconsideration also contain a list of registrations without copies of the registrations themselves. These registrations do not appear, in general, to be any more relevant than the registrations of record. However, we agree with the examining attorney that these registrations are not properly of record. In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record"). Also, in its briefs, applicant refers to another of its application as evidence that the services in this case are not related. No evidence on this point was submitted. It is well-settled that the Board is not bound by prior decisions of Trademark Examining Attorneys, and that we must decide each case on its own merits and on the record before us. See, e.g., In re International Flavors & Fragrances Inc., 183 F.3d 1361, 51 USPQ2d 1513, 1518 (Fed. Cir. 1999) ("Each application for trademark registration must be considered on its own merits"); In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some registrations had some

evidence of use and they are for very different services. Therefore, they do not demonstrate that registrant's mark for its services is entitled to only a narrow scope of protection.

Finally, even if we had any doubts about whether there is a likelihood of confusion, we must resolve them in favor of the prior registrant and against the newcomer. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.

characteristics similar to Nett Designs' application, the PTO's allowance of such registrations does not bind the Board or this court"); In re Cooper, 254 F.2d 611, 117 USPQ 396, 401 (CCPA 1958) ("...the decision of this case in accordance with sound law is not governed by possibly erroneous past decisions by the Patent Office"). In this case, as "in Cooper, we do not here have sufficient facts before us on which to evaluate whether the previous action of the Examiner which resulted in issuance of the previous registration was or was not erroneous. Nevertheless, as Cooper held, it is sufficient that the facts now before us and the application to them of sound law persuade us that the mark does not meet the requirements for registration set forth in Sections 2(d) ... of the statute." In re National Retail Hardware Association, 219 USPQ 851, 854 (TTAB 1983).